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In re Application of :
Koike et al. :
Application No. 09/725,496 :
Filed: November 30, 2000 : ON PETITION
Attorney Docket No.: :
PM 275294 FOO-212-US :

OFFICE OF PETITIONS

This is a response to the Petition to Accept Drawings and to Grant Original Filing Date, filed January 25, 2001, requesting that the above-identified application be accorded a filing date of November 30, 2000, rather than the presently accorded filing date of January 17, 2001. The application was recently forwarded to this Office for consideration of the petition.

The petition is granted in part and dismissed in part. The petition to accept drawings is dismissed. The petition to grant original filing date is granted.

The application was filed on November 30, 2000. However, on January 3, 2001, Office of Initial Patent Examination mailed a Notice of Incomplete Nonprovisional Application (hereinafter "Notice"), requiring drawings of applicant's invention and stating that the filing date of the application would be the date of receipt of the omitted drawings.

In response, on January 25, 2001, the petition and drawings of Figures 1-4, 5a-5c, and 6-10 were filed. The petition requests the earlier filing date on the basis that the invention consists in making an article of a particular material or composition and that significant details of structure or arrangement are not involved in the article claims. See Manual of Patent Examining Procedure ("MPEP") 601.01(f).

Applicable Law

The MPEP, §601(f), provides that

[o]ther situations in which drawings are not usually considered necessary for the understanding of the invention under 35 USC 113 (first sentence) are:

(B) Articles made from a particular material or composition: where the invention consists in making an article of a particular material or composition, unless significant details of structure or arrangement are involved in the article of claims;

Petitioner is correct in that at least one claim is directed to a composition. The application should, therefore, have been treated as an application for which a drawing is not necessary for an understanding of the claimed subject matter.

Petitioner's Options

The MPEP, §601(f), further provides that

[a] nonprovisional application having at least one claim . . . directed to the subject matter discussed above for which a drawing is usually not considered essential for a filing date, describing drawing figure(s) in the specification, but filed without drawings will be treated as an application filed without all of the drawing figures referred to in the specification as discussed in MPEP §601.01(g), so long as the application contains something that can be construed as a written description.

Section 601.01(g) provides that an application filed without all figures of drawings will be accorded a filing date, however, a Notice of Omitted Items will be mailed indicating that the application lacks some of the figures of drawings described in the specification.

The mailing of a 'Notice of Omitted Item(s)' will permit the applicant to either: (1) promptly establish prior receipt in the USPTO of the drawing(s) at issue (generally by way of date-stamped postcard receipt (MPEP 503)) (by filing a petition under 37 CFR 1.53); or (2) promptly submit the omitted drawing(s) in a nonprovisional application and accept the date such submission as the application filing date (by filing a petition under 37 CFR 1.182). See MPEP 601.01(g).

Petitioner has one other option: "An applicant willing to accept the application as deposited in the USPTO need not respond to the 'Notice of Omitted Item(s)', thereby constructively accepting the application as deposited with this Office. Amendment of the specification is required . . . to cancel all references to the omitted drawing[s]. . . ." See MPEP 601.01(g).

Conclusion

Since applicants maintain that the drawings are not necessary, the application will be accorded the November 30, 2000 filing date without the drawings of Figures 1 - 4, 5a - 5c, and 6 - 10. The Notice mailed January 3, 2001 is hereby withdrawn.

The **petition is granted** to the extent that the application will be accorded a filing date of November 30, 2000, however, the **petition is dismissed** to the extent that drawings filed with the instant petition will not be accepted.


No petition fee is required. Deposit account number 03-3975, has been credited with the petition fee, \$130.00, as per the authorization in the instant petition.

The drawings of Figures 1-4, 5a-5c, and 6-10, filed on January 25, 2001, are not part of the original disclosure of the application and will not be entered.

An amendment canceling the references to Figure 1-4, 5a-5c, and 6-10 in the specification should be filed prior to the first Office action in order to avoid further delays in the prosecution of the application.

The application is being returned to the Office of Initial Patent Examination for further processing with a filing date of November 30, 2000, and an indication that "0" sheets of drawings were present on filing.

Telephone inquiries concerning this matter should be directed to Petitions Attorney Derek L. Woods at (703) 305-0014.


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